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Dana B. Taschner

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EXAMINER

BROOKS, MATTHEW L

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,895

Applicant(s)

TASCHNER, DANA B.

Examiner

Matthew L. Brooks

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: Page 12, lines 5-10; "...clams..." and "...speed of deliver...".

Appropriate correction is required.

Claim Objections

2. **Claims 1, 7, 13, 19 and 20** are objected to because of the following informalities: "government" and "category" are spelled improperly. Appropriate correction is required.
3. **Claim 3** is objected to for the use of the word "his", is examiner to believe that only a male may be a consumer? Appropriate correction is required.

Claim Rejections - 35 USC § 112 2nd

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1, 7, and 13** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

In the preamble the Applicant presents "A method to obtain consumer inquiries and resulting employment from consumers..." In the body of the claim neither result and the steps thereof are presented or accomplished.

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6. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. **Claim 2** recites the limitation "...for the consumer..." yet no consumer has yet been introduced only a method to obtain consumer inquiries. There is insufficient antecedent basis for this limitation in the claim.

8. **Claim 7** recites the limitation "... said attorneys..." yet no foundation has been laid or an introduction of an attorney can be found. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as

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opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

In the present case, the applicant is merely creating an internet web-site. This may be done on a piece of paper at a person's desk or even in one's head. Even the code thereof may be drafted on paper...all of the above can be done with out the use of technology or a computer.

Appropriate action is required.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. **Claims 1-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over CaseMatch (For purposes of examination CaseMatch is comprised of CaseMatch the Patent Number 6,470,338; Rizzo (CaseMatchP) and the website thereof received from the "wayback machine" as of 5/10/2000 attached herein (CaseMatchW).

13. With respect to **Claims 1, 7, 13 and 19:**

CaseMatch discloses a method of obtaining consumer inquiries (CaseMatchW, B1 and E(ii)) and resulting employment from consumers who have a legal matter that needs resolution (CaseMatchW A1, (ii), b)

CaseMatch does not discuss creating a special interest web site, a website specifically for dangerous or defective products with all of the specific links and sub-links as claimed. In determining the obviousness of applying what is generally known in the field of legal service, advertising thereof to what is known in the world of the Internet one must determine the level of ordinary skill (*Dann v. Johnston*, 425 U.S. 219, 189 USPQ 257 (1976)). The Internet, to one ordinarily skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be to set up a web site which is composed of a homepage comprising links to other relevant sites of interest to the user of the site. Said links link to specific sub-sites relating to the link clicked on (each site thereof with its own URL). Having a link to contact another person or user provided by said website is widely known in Internet world. Also the Legal Service industry has utilized computers and specific websites pertaining to legal need for years for attorneys in the specific field to make themselves known in a particular industry and for developing client contact, and

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employment in their field of endeavor, across the world. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have utilized the Internet and a specific website thereof tailored to defective or dangerous products with linkage of any type of information thereon in order to attract clients of a more particular or special legal need to the database of attorneys provided by CaseMatch and better utilize CaseMatch's method of receiving inquiries and resulting employment to provide more information to resulting client regarding their particular need.

14. With respect to **Claims 2, 8 and 15**:

CaseMatch discloses a means for the consumer to contact an attorney by email or by questionnaire (CaseMatchW, B1 and A1, (ii), b also CaseMatchP Column 1, 45-60 and Column 4, 1-43 NOTE: CaseMatch discloses wherein the clients information/questionnaire is sent to the attorney. The attorney contacts client which meets the limitations of the claim. However it should be noted that no patentably distinct difference would be found if Applicant were to modify the claim to where the potential client contacted directly the potential attorney because as discussed above this was old and well known with in the art and furthermore is shown as an embodiment with in CaseMatchP Column 6, 35-60)

15. With respect to **Claims 3, 5, 9, 11, 16 and 17**:

CaseMatch discloses wherein the questionnaire requires the consumer to fill in certain data fields including name, address, phone number and basic description of legal claim or service need ("general information about case" / and practice area need CaseMatchW, B1. CaseMatch teaches all of the elements claimed with the exception of

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requiring the consumer to indicate whether or not the consumer to indicate whether or not s/he has been injured by the product and whether or not the consumer has had medical treatment and automatic rejection of the case if neither is present. The examiner takes Official Notice that it is well established that in product liability cases there are two essential elements 1. Has the plaintiff been injured and 2. are the damages medically diagnosable and an attorney would be inclined to receive the above information before the acceptance of a case. Evidence of this is provided by the following example of if a potential client calls a law firm/ attorney saying that they wanted to sue the manufacturer of a product the attorney would ask the potential client "have you been injured and have you seen a doctor?" It would have been obvious to one of ordinary skill in the art at the time of the invention to include Applicant's received inquires in the system of CaseMatch because asking the questions initially would allow the inquiring attorney to save the time to contact the potential client and ask the exact same question. The use and advantages of this step are well known.

Note the added step of automatically electronically rejecting the questionnaire if the consumer indicates no, is merely the automation of the old and well known manual process of asking the potential client the received information via phone, email inquiry or an in face interview, wherein if the attorney received no to the same questions the result would be the same, a rejection or refusal to take the case. It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example,

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simply automating the step of asking the client have you been injured and are the damages medically diagnosable and automatically rejecting the case based upon the information from the customer (if the consumer indicates no) gives you just what you would expect from the manual step of doing so. In other words there is no enhancement found in the claimed step. The claimed collection of received information and automatic rejection step only provides automating the manual activity. Which only gives just what one would expect from the manual steps shown in the reference. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the collection of received data (1. injuries 2. medically diagnosable) because this would speed up the process of matching attorneys with customers, which is purely known, and an expected result from automation of what is known in the art.

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automatically electronically reject based upon an indication of no since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

16. With respect to **Claim 4, 10 and 14:**

CaseMatch shows wherein a completed questionnaire is electronically sent to an

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attorney located in a different geographical area or in the geographical area of the consumers address or located closest to the consumer (CaseMatchW B1 and CaseMatchP Column 3, 25-28 and Column5, 1-10 and Column 6 5-20).

17. With respect to **Claim 6, 12 and 18**:

CaseMatch shows wherein the completed questionnaire is also stored in a database (CaseMatchW Fig 4 "added to database" and Column 1, 52-55)

18. **Claim 20, 21, 22 and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over CPSC.gov (CPSC) as of 5/10/2000 (attached herein).

CPSC shows an Internet portal dealing with dangerous or defective products comprising a plurality of first sub-portals, each sub-portal containing dangerous or defective product information and links to government resources and agencies, manufacturers, health and medical organizations and, a plurality of second sub-portals for each category of dangerous or defective products, a plurality of third sub-portals, each third sub-portal containing information on a specific dangerous or defective product within a second sub-portal category wherein each web site has its own uniform record locator (Note: Internet web site is equivalent to internet portal and link thereon is equivalent to sub-portal and so on and so on).

CPSC does not expressly show the first Internet portal having a link to a liability attorney or any. However the specific links and titles thereof does not patentably distinguish the claimed system. Further, the recited statement of intended use, to use

the web page and links to learn more about dangerous and defective products and employ an attorney, does not patentably distinguish the claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of linkage in the system taught by Reference CPSC because the actual destination of the linkage does not patentably distinguish the claimed invention; a web page and/or network system.

NOTE: Any website, regardless of its content could be used to reject this website/system so long as 3 levels of linkage were provided, because the difference in the names given to the links are merely Non-Functional Descriptive data and are not functionally involved in the steps recited. The linkage of a homepage to another webpage (sub-portal) to another web page (and so on) would be performed the same regardless of the data thereon. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (*see In re Gulack*, 703 F.2d 1381; *In re Lowry*, 32 F.3d 1579).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to link on an initial webpage (homepage) any type of link to another webpage (sub-portal) with any type of content because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

19. With respect to **Claim 23**:

Any website, regardless of its URL could be used to reject this system/website, because the difference in the names given to the links or URL are merely Non-

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Functional Descriptive data and are not functionally involved in the steps recited. The actual naming of a homepage to reflect its contents would still perform the same linking function when clicked upon regardless of the name given to it. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (see *In re Gulack*, 703 F.2d 1381; *In re Lowry*, 32 F.3d 1579).

Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to name the URL any type any type of name with any type of content because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

To reemphasize the non-patentability of the claim the Examiner now (unnecessarily) takes the time to issue another rejection the examiner takes Official Notice that having the URL or name of the website reflect the website's contents is old and well established in the business of e-commerce as a convenient way for a consumer to recognize the contents of the website, conduct more efficient searches on search engines and take a guess of a website before conducting a search. Evidence of this is provided by the following example of if one were looking for a dentist or to order flowers on the web a customer would be inclined to type in the URL "dentist.com" or "flowers.com" respectively. It would have been obvious to one of ordinary skill in the art at the time of the invention to have the URL reflect the term "recalled" and the name of the specific dangerous product in the website/system of CPSC because the naming as such of the URL would allow the user to easily see which product s/he was looking at or

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take a guess at the appropriate URL which contained the information that the consumer was looking for. The use and advantages of this step are well known.

20. **Claims 24-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over CPSC in view of CaseMatch.

21. With respect to **Claim 24**:

CaseMatch discloses a means for the consumer to contact an attorney by email or by questionnaire (CaseMatchW, B1 and A1, (ii), b also CaseMatchP Column 1, 45-60 and Column 4, 1-43 NOTE: CaseMatch discloses wherein the clients information/questionnaire is sent to the attorney. The attorney contacts client which meets the limitations of the claim. However it should be noted that no patentably distinct difference would be found if Applicant were to modify the claim to where the potential client contacted directly the potential attorney because as discussed above this was old and well known with in the art and furthermore is shown as an embodiment with in CaseMatchP Column 6, 35-60).

22. With respect to **Claim 25 and 27**:

NOTE: Applicant is reminded that "capable" is the standard being applied and that CaseMatch and/or CPSC or both certainly capable of performing the functions of receiving an email or questionnaire and automatically rejection. However, Examiner now takes the extra time to apply the extra rejection below.

CaseMatch discloses wherein the questionnaire requires the consumer to fill in certain data fields including name, address, phone number and basic description of legal claim or service need ("general information about case" / and practice area need

CaseMatchW, B1. CaseMatch teaches all of the elements claimed with the exception of requiring the consumer to indicate whether or not the consumer to indicate whether or not s/he has been injured by the product and whether or not the consumer has had medical treatment and automatic rejection of the case if neither is present. The examiner takes Official Notice that it is well established that in product liability cases there are two essential elements 1. Has the plaintiff been injured and 2. are the damages medically diagnosable and an attorney would be inclined to receive the above information before the acceptance of a case. Evidence of this is provided by the following example of if a potential client calls a law firm/ attorney saying that they wanted to sue the manufacturer of a product the attorney would ask the potential client "have you been injured and have you seen a doctor?" It would have been obvious to one of ordinary skill in the art at the time of the invention to include Applicant's received inquires in the system of CaseMatch because asking the questions initially would allow the inquiring attorney to save the time to contact the potential client and ask the exact same question. The use and advantages of this step are well known.

Note the added step of automatically electronically rejecting the questionnaire if the consumer indicates no, is merely the automation of the old and well known manual process of asking the potential client the received information via phone, email inquiry or an in face interview; wherein if the attorney received no to the same questions the result would be the same, a rejection or refusal to take the case. It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior

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art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of asking the client have you been injured and are the damages medically diagnosable and automatically rejecting the case based upon the information from the customer (if the consumer indicates no) gives you just what you would expect from the manual step of doing so. In other words there is no enhancement found in the claimed step. The claimed collection of received information and automatic rejection step only provides automating the manual activity. Which only gives just what one would expect from the manual steps shown in the reference. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the collection of received data (1. injuries 2. medically diagnosable) because this would speed up the process of matching attorneys with customers, which is purely known, and an expected result from automation of what is known in the art.

Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automatically electronically reject based upon an indication of no since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

23. With respect to **Claim 28**:

CaseMatch shows wherein the completed questionnaire is also stored in a database (CaseMatchW Fig 4 "added to database" and Column 1, 52-55)

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. How to use Internet information in your practice, Chovanes Joseph E, Practical Litigator v8 n4 pp: 51-61 Jul 1997. Which looks like a cut and paste of the Applicant's specification in regards to the benefits of being a lawyer and having a site on line and also shows that linking up to a special interest web site is old and well known with in the art on page 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew L. Brooks whose telephone number is (571) 272-8112. The examiner can normally be reached on Monday - Friday; 8 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-8112. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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